From:

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Sir:

The following comments represent my own views on the subject.

With respect to item I (Current USPTO Prior Art Resources), A (US Patents) -- 1 (Classified) or 2 (Text), and B (Foreign Patents):

Use should be made by searchers/examiners of the International Patent Classification system in addition to the other means mentioned. Foreign patents especially are classified by subject using this system and the Int. Cl. search field is available on most computer databases. This could be combined with a keyword search using boolean operators. Even for US patents, an international classification is assigned by the USPTO at issuance, and reviewed and reassigned (and presumably kept current) by the European patent office. Because the US and International subject matter classification systems differ in concept and overall arrangement , as well as subclass scope and definition, a search in an appropriate subclass in each system will usually uncover different sets of patents.

With respect to item I (Current USPTO Prior Art Resources), C (Non-Patent Literature):

I note a potential over-reliance on newspaper and other journalistic sources in the core database list and even in some of the subject specific lists. While these sources can point to the existence of more relevant prior art, by themselves newspaper articles, press releases and the like tend not to be very helpful in properly characterizing the actual content of prior art methods and corresponding apparatus and software, and their probative value is limited.

They are very rarely written by persons of ordinary skill in the art of the subject being reported. Despite their best efforts, even conscentious journalists may not completely understand the technology they are writing about, may introduce errors and may exaggerate the importance of aspects of a technology, which to an ordinary artisan may seem trivial. The latter case (exaggeration) could even occur because the journalist's contact is not the inventor or someone intimately involved in a development project, but is instead a company's marketing spokesperson.

More importantly, such articles tend to report what a method or apparatus does (ie the resulting effects) without detailing in any useful manner how it does what it does (ie the technical features). This makes it very difficult for both examiners and applicants to properly evaluate whether or not what is reported actually reads on or makes obvious the claimed subject matter of an application.

Also, the abundance of pre-release announcements in this field points to the fact that what is reported may not yet have been successfully reduced to practice or even that the development team has yet conceived an enabling embodiment. All that can be inferred in some cases is that someone in the field is doing work on a potential future product, not the extent of the progress. (For example, prior to the Wright brothers flight, there were no doubt many articles in newspapers about inventors trying to develop heavier-than-air powered flying machines. The existence of such "prior art" newspaper articles did not make the Wright brother's successful airplane obvious in view of those articles, even though the articles reported the work of other

artisans. More pertinent is the numerous cases in which pre-announced software release dates are continually pushed back, sometimes over a year after the first announcement, thus indicating that the pre-announcements were more wishful thinking than actual achievement.)

Hence, searchers/examiners should be cautioned against over-reliance on such sources. Rather, they are useful in identifying places to look for more relevant information (data sheets, peer-reviewed journal articles, identification of possible inventor or author names, etc).

Sincerely, Mark Protsik
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